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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,001	08/01/2003	Walter Harvey Waddell	2003B079	8961

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EXXONMOBIL CHEMICAL COMPANY
5200 BAYWAY DRIVE
P.O. BOX 2149
BAYTOWN, TX 77522-2149

EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/633,001	Applicant(s) WADDELL ET AL.	
	Examiner Vickey Ronesi	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 0405.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25,27-35,38-43 and 46-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25,27-35,38-43 and 46-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/4/2005 has been entered.
2. All outstanding rejections are withdrawn in light of applicant's amendment filed 8/4/2005.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-25, 27-35, 38-43, and 46-83 are rejected under 35 U.S.C. 102(b) as being anticipated by Dias et al (WO 02/48257 A2, cited on IDS dated 12/15/03).

Dias et al discloses a composition that can be used in the production of air barriers having an air permeability from 1.2×10^{-8} to 4×10^{-8} cm³-cm/cm²-s-atm at 65°C (page 58, lines 29-30) such as innerliners and innertubes (page 34, lines 5-9) comprising

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- from 5 to about 100 phr (page 13, lines 5-14) of an elastomeric component such as halogenated (polyisobutylene-*co-p*-methylstyrene) which contains 0.1-5 wt % *p*-methylstyrene (page 54, lines 12-13) wherein the halogen is preferably bromine (page 11, lines 19-25), butyl rubber (page 6, line 10), halogenated star-branched butyl rubber, halogenated butyl rubber, and mixtures thereof (page 53, lines 10-12);

- from about 10 to about 150 phr (page 21, lines 12-13) of carbon black which are useful in innerliners and innertubes such as N762, N990, and Regal 85 which inherently has a surface area of less than $30 \text{ m}^2/\text{g}$ and a dibutylphthalate oil absorption of less than $80 \text{ cm}^3/100 \text{ g}$ (as disclosed by present disclosure on page 25, Table 2) or carbon black such as N660 which inherently has a surface area greater than $30 \text{ m}^2/\text{g}$ and a dibutylphthalate oil absorption of greater than $80 \text{ cm}^3/100 \text{ g}$ (as disclosed by present disclosure on page 25, Table 2);

- from about 1 to about 60 phr (page 21, lines 1-4) polybutene processing oil derived from olefin derived units have from 3 to 8 carbon atoms, in particular a C_4 raffinate (page 17, lines 23-29), such as those described on page 18, lines 4-21) having a viscosity ranging from 10 to 6000 cSt at 100°C (page 19, lines 2-5) and having $M_n > 400$ and $M_n < 15,000$ (page 17, line 25; page 18, lines 23-28);

- at least one filler such as those listed on page 21, lines 8-21;

- an exfoliated clay such as those listed on page 21, line 23 to page 22, line 2;

- a secondary elastomer such as those listed on page 13, lines 17-29;

- an engineering resin such as a polyamide and others such as those listed on page 15, lines 19-24;

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- processing aids such as naphthentic, aromatic or paraffinic extender oils may be present or substantially absent (page 23, line 29 to page 24, line 4); and

- at least one curing agent (page 25, lines 11-15).

The above composition is mixed together and cured (page 25, line 17 to page 28, line 3).

In light of the above, it is clear that Dias et al anticipates the presently cited claims.

Response to Arguments

4. Applicant's arguments filed 8/4/2005 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that the presently claimed range of carbon black with presently claimed type of carbon black is not disclosed with sufficient specificity and (B) that Dias does not disclose specific examples of Applicants' claimed ranges or type of carbon black

With respect to argument (A), the amount of carbon black disclosed by Dias et al of 10-150 phr substantially overlaps the presently claimed range of 80-200 phr and therefore discloses with sufficient specificity the presently claimed amount of carbon black. In particular the range of 80-150 phr is common to both Dias et al and the present invention. Moreover, Dias teaches the use of 6 carbon blacks in innerliners or innertubes (page 21, lines 18-21), 3 of which (N762, N990, and Regal 85) undoubtedly read on the presently claimed carbon black. Thus, it is the examiner's position that Dias discloses with sufficient specificity the presently claimed carbon black in the presently claimed amounts.

With respect to argument (B), examiner agrees that Dias does not exemplify a composition with the presently claimed carbon black in the presently claimed amount,

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nevertheless, case law holds that "applicant must look to the whole reference for what it teaches.

Applicant cannot merely rely on the examples and argue that the reference did not teach others."

In re Courtright, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967).

Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/15/05

vr



Vasu Jagannathan
VASU JAGANNATHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700